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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,637	10/23/2002	Alexander Sher	112843-028	8331
29157	7590	11/08/2004	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			PRATT, HELEN F	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/914,637

Applicant(s)

SHER ET AL.

Examiner

Helen F. Pratt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 8, 14-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nash et al. (WO 98/21953).

Nash et al. disclose a liquid nutritional supplement as in claims 3 and 14, which is made by dissolving a casein source in water and by dissolving a mineral mixture in water, both forming slurries which are mixed together and then the pH is adjusted to from 6.9 to 7.0 except that the solutions are not adjusted to the claimed pH before they are combined (page 10, lines 24-35 and page 11, lines 10-11, 32-33). The ferric state must have been maintained because the iron does not cause discoloration of the liquid supplement during thermal processing (page 11, lines 24). Nothing is seen at this time that the pH's of the two solutions were not within the claimed level since the ferric state is maintained. Claim 3 is also a product by process claim. The fact that the procedures of the reference are different than that of applicant is not a sufficient reason for allowing the product-by-process claims since the patentability of such claims is based upon the product formed and not the method by which it was produced. See *In re Thorpe* 227 USPQ 964. The burden is upon applicant to submit objective evidence to support their position as to the product-by-process claims. See *Ex parte Jungfer* 18 USPQ 2D 1796.

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Therefore, it would have been obvious to make a ferric-caseinate complex since the claimed product has been shown.

Claim 4 further requires fat. The reference discloses the addition of safflower oil to the composition (page 12, lines 33-37). Therefore, it would have been obvious to add oil to a ferric caseinate complex as disclosed by Nash et al.

Claim 8 further requires that the liquid beverage containing ferric-caseinate and lipids be retorted. Nash et al. discloses that their beverage is sterilized which is what retorting does (page 17, lines 27-32 and page 18, lines 1-4, page 8, lines 4-19). The particular process is not given weight in a composition claim. Therefore, it would have been obvious to heat sterilize a liquid beverage composition as claimed.

The limitations of claims 1, 15-17, 19-21, 23-25 have been discussed above and are obvious for those reasons.

Claims 5-7, 9, 10, 13, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above reference (Nash) as applied to the above claims and further in view of Dolan et al. (H1620) and Myers et al.

Claims 5 and 22 further requires the addition of polyphenols. Nash et al. disclose that flavorings can be added to the composition (page 17, lines 9-10). Chocolate is another known flavorant for beverages, which are milk- like. Dolan et al. disclose that it is known to make a chocolate flavored beverage mix containing iron (col. 10, lines 55-60). Chocolate is known to contain polyphenols as disclosed by Myers et al. (col. 1, lines 20-70). Therefore, it would have been obvious to use a flavorant such as chocolate, which contains polyphenols in the claimed process of Nash et al.

Dolan et al. disclose a chocolate beverage base (mix) as in claims 6 and 13 (abstract) and beverages are disclosed as in claim 7 (col. 8, lines 55-60). Therefore, it would have been obvious to use the composition of the combined references to make as chocolate base or drink.

Claim 9 further requires that the beverage is chocolate and claim 10 requires a retorted liquid with polyphenols. The claimed limitations have been shown above and are obvious for those reasons.

Claim 11 further requires that the beverage is a tea beverage. As above, Nash discloses that his composition can contain various flavorings. Tea is a flavoring. Therefore, it would have been obvious to add tea to the composition of Nash et al. to add flavoring.

Claims 2, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan et al. in view of (WO 98/42745) Sakurai et al. and Hidalgo et al. (4,303,580).

Claims 2 and 12 further require that the composition is a beverage powder. In re Thorpe, supra applies to all the instant compositions. Dolan et al. disclose a dried beverage powder (abstract). Claim 12 differs from the reference in the use of a ferric-caseinate complex made by a particular method. Sakurai et al. disclose an iron casein complex which is a ferric caseinate complex made by a different method (abstract) and col. 8, lines 20-40). Hidalgo et al. disclose a caseinate in powder form, which contains ferric iron (col. 1, 20-34, lines 60-70 and col. 2, lines 1-4, col. 3, lines 18-24). The iron caseinates can be used in infant and dietetic products (abstract). Therefore, it would have been obvious to use the ferric caseinates of Sakurai et al. and Hidalgo et al. in

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place of the iron in Dolan et al. 's cocoa product due to their more desirable palatability (Sakurai et al. col. 1, lines 20-65).

### ARGUMENTS

Applicant's arguments filed 9-2-04 have been fully considered but they are not persuasive. Applicants argue that Nash provides a recipe for a liquid supplement and fails to describe a ferric caseinate complex and that Nash contains different concentrations of macronutrients and micronutrients. However, claim 1 only requires a fortification system containing ferric-caseinate complex made by a particular method. As in *In re Thorpe*, above, no weight has to be given to the process of making the product in a composition claim. The reference to Nash does disclose dissolving a macronutrient mixture in heated water (calcium sodium caseinate), and adding a mineral, which can be iron (page 6, lines 8-25). Applicants' casein is not limited to any particular type of casein nor is the ferric salt. No particular concentrations of the other nutrients are claimed.

Applicants argue that the references to Dolan and Myers et al. are not combinable because Dolan in particular does not describe an iron fortification system. However, Nash is used in view of Dolan (page 3 of office action "unpatentable over the over reference" ("over" should have been "above") and Myers. This argument is not persuasive because Dolan discloses adding polyphenols to a chocolate beverage and Myers discloses that chocolate already contains polyphenols. Nothing has been shown that the addition of polyphenols to the claimed beverage affects the iron fortification system.

Applicants argue that the date for Sakurai is not good. However, the WO reference has been inserted instead of the '258 reference whose date is good.

Applicants argue that both Sakurai and Hidalgo do not disclose a ferric caseinate reference that is made as claimed. However, the method of making does not have to be considered in a composition claim, absent a showing that a product is made using the claimed method does not produce the claimed product (Thorpe, supra).

Applicants argue that the iron-casein complexes of Sakurai are made by a particular method and will add ingredients to the complex. However, no ingredients have been excluded and nothing is seen that the product would not perform the claimed function. It is not seen how the solubility of the ferric complexes will be different than that claimed as they are using a ferric salt (ferric chloride and a casein solution (col. 3, lines 15-30)).

As to Hildago, it is not seen that applicants' claims exclude any products except for the claimed ones.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hp 10-29-04

  
HELEN PRATT  
PRIMARY EXAMINER